

Application No.: 10/705,406

Docket No.: 20050/0200470-USO

REMARKS**Pending Claims**

Claims 1-16 are pending. Although, the Office Action only mentions claims 1-15, there are 16 claims as of November 10, 2003, when a first preliminary amendment was filed together with the application. Claim 16 is essentially the same as claim 14 except being dependent from claim 2.

Claim 1 has been cosmetically amended to remove informalities and redundancies. No new matter has been added. New claims 17 and 18 have been added. These claims are supported by the original claims, the specification, and the drawings. No new matter has been added.

Claim Rejections – 35 USC §103

Claims 1-13 have been rejected under 35 USC §103 as being unpatentable over Johnson (US Patent No. 4,595,392).

Applicants respectfully submit that the claimed invention as set forth in claims 1-13 are not obvious from the prior art reference, Johnson, for at least the following reason.

Claim 1 recites as follows:

Claim 1 (currently amended): An interlabial pad, comprising:
an absorbent body or absorbing body fluid, said absorbent body being enclosed in the interlabial pad; said interlabial pad having a size adapted to be pinched between the labia of a wearer and having a shape including a longitudinal axis direction and a lateral axis direction,

wherein a pair of fingertip insert openings having a size for inserting the fingertips of a wearer are provided in said interlabial pad, and said pair of fingertip insert openings are provided symmetrically on both opposite sides of said interlabial pad and about a center axis coinciding with said longitudinal axis direction, and the interlabial pad is adapted to be folded at the center axis.

(Emphasis added.)

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The above bolded feature is not disclosed, taught, or suggested by the cited prior art reference. According to the present invention as set forth in claim 1, because a pair of fingertip insert openings are symmetrically provided at opposite sides of the interlabial pad, the interlabial pad can be held firmly with a pair of fingers to be easily inserted into the labia.

It is stated in the Office Action on pages 2 and 3 that:

Johnson does not specifically disclose a pair of fingertip openings, however, Johnson discloses the size of the opening between securement means determines whether a single digit or several fingers are used for positioning purposes (col. 2, lines 44-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make a pair of openings as opposed to one opening, since it has been held that "constructing a formerly integral structure in various elements involves only routine skill in the art." *Nerwin v. Erlichman* 168 USPQ 177, 179.

Applicants submit that it would not have been obvious for a person of ordinary skill in the art to modify Johnson to arrive at the presently claimed invention as set forth in claims 1-13 because there is no suggestion or motivation to do so as suggested by the Examiner.

The cited passage, column 2, lines 44-48 in Johnson states: "As can be seen by reference to FIG. 3, the space between securement means 4 on the bottom inner side of the centrally disposed portion 3 determines whether a single digit or several fingers are used for positioning purposes." (Emphasis added.) What this means that the space between the securement means can be small or large to accommodate one finger or several fingers. As can be seen in Fig. 3, there is only a single opening located on the bottom inner side of the centrally disposed portion 3 of the pad. There is no description in the specification or no drawings regarding a pair of fingertip insert openings provided symmetrically on both opposite sides of said interlabial pad and about a center axis coinciding with said longitudinal axis direction.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313,

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1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

Here, in the present case, Johnson discloses a single space for inserting finger/fingers from the bottom inner side of the centrally disposed portion 3. The reference does not explicitly or implicitly teach or suggest to one of ordinary skill in the art a pair of fingertip insert openings provided symmetrically on both opposite sides of said interlabial pad and about a center axis coinciding with said longitudinal axis direction.

Applicants further point out that the application of *Nerwin v. Erlichman* is misplaced. Nowhere does *Nerwin v. Erlichman* state "constructing a formerly integral structure in various elements involves only routine skill in the art." The closest statement on page 179 is "the mere fact that a given structure is integral does not preclude its consisting of various elements." The latter true quote is vastly differently from the first statement. Applicants submit that *Nerwin v. Erlichman* is not controlling on the issue at hand.

Even if *Nerwin v. Erlichman* made such a statement as alleged by the Examiner, how does this general statement about an integral structure with presumably known elements¹ involved in an interference proceeding apply to the present instance where the reference at hand does not disclose, teach or suggest the above bolded elements of claim 1? Is the Examiner implying that constructing an integral structure in various elements, whether they are known or unknown to the public, involves only routine skill in the art? Surely, that cannot generally be a true proposition.

For at least the foregoing reasons, the present invention as set forth in claim 1 is not disclosed, taught, or suggested by the cited prior art reference. Claims 2-13 depend from claim 1 directly or indirectly. Therefore, these claims are not obvious for at least the same reasons as claim 1.

Claims 14 and 15 have been rejected under 35 USC §103 as being unpatentable over Johnson in view of Farris.

¹ *Nerwin v. Erlichman* is a ruling on interference where all the elements are known to the parties.

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Applicants submit that because claims 14 and 15 (and 16) depend from claim 1, these claims are not obvious for at least the same reasons as claim 1. Farris also does not disclose, teach, or suggest the bolded feature of claim 1 shown above.

New claims 17 and 18 have been added. These claims describe a pair of fingertip insert openings symmetrically disposed about a longitudinal direction of the interlabial pad. For at least this reason, claims 17 and 18 are not obvious from the cited prior art, Johnson.

Claim 18 (and claims 7 and 8) further describes a folding guide element for guiding the folding of the interlabial pad. Such an element is not disclosed, taught, or suggested by the cited prior art references. For at least these reasons, claims 7, 8, and 18 are not obvious from the cited prior art references.

For at least the foregoing reasons, all pending claims are believed to be allowable over the cited prior art references.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By 

Chris T. Mizumoto

Registration No.: 42,899

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant

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